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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/7934, 968	09/22/97	BELL	D 4239UF4925

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EXAMINER

FHAN, R

ART UNIT

PAPER NUMBER

2781

DATE MAILED: 04/12/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>08/934,968</b>	Applicant(s) <b>Bell</b>
	Examiner <b>Raymond N. Phan</b>	Group Art Unit <b>2781</b>

Responsive to communication(s) filed on Feb 22, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-10 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### Part III **DETAILED ACTION**

#### *Notice to Applicant(s)*

1. This action is responsive to the following communications: amendment filed on February 22, 1999.
2. This application has been examined. Claims 1-10 are pending.

#### *Claim Rejections - 35 USC § 112*

3. Claims 3-4, 7-8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, have been withdrawn in view of the amendments to the claims by the Applicants on February 22, 1999.

#### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward (US No. 5,448,708) in view of Glassen et al. (US No. 5,671,441).

In regards to claims 1, 5, and 9, Ward discloses the method and apparatus for dynamically sending device data in the bus transaction comprising first device 88 issue request comprising a device control/data field; the second device 100 generating and issue a reply comprising a plurality of field and wherein the second device copying data received from the first device into the designate field of the

plurality of field of the reply (see col. 11, lines 7-51). But Ward does not disclose the field including the device configuration field. However Glassen et al. disclose the field including the device configuration field (see col. 5, line 65 through col. 6, line 31). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to have combined the teachings of Glassen et al. into the teachings of Ward because it would provide the dynamical configuration for device in the computer system.

In regards to claims 2 and 6, Ward discloses the designated field is located at a location in the reply that corresponds to a field location of the device configuration of the request (see col. 11, line 52 through col. 12, line 20).

In regards to claims 3, 7, and 10, Ward discloses the device configurable field is used by the first device to store an transaction identification of the transaction issued by the first device (see col. 11, lines 38-52).

In regards to claims 4 and 8, Ward further discloses the first device reading the designated field to determine the identification to the request the reply corresponding to (see col. 12, lines 22-40).

#### *Response to Arguments*

6. In view of remark filed on February 22, 1999, claims 1-10 have been fully considered but they are not deemed to be persuasive.

Applicant(s) argue that ...Ward et al. fails to teach or suggest first device issuing the request to the second device; the second device generates the reply (page 2). The Examiner respectfully traverses. Ward et al. teach the first device (i.e. Unit X) issuing the request to second device (i.e. Unit Y) for transferring including the

surrogate control information; writing the first surrogate control information from the first device to the shared memory for the use by the second device; the second device generates the second surrogate control information (i.e. reply) from the memory to the first device (see col. 8, lines 10-68).

Applicant(s) argue that Glassen et al. fails to remove the shortcoming of Ward et al. (page 3). The Examiner respectfully traverses. Glassen et al. disclose the plurality of fields including device configurable data (see col. 5, line 65 through col. 6, line 5).

In response to applicant's argument that the combination of Ward et al. and Glassen et al., the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### ***Conclusion***

7. All claims are rejected.
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Raymond Phan, whose telephone number is (703) 306-2756. The examiner can normally be reached on Monday-Thursday from 6:30AM- 4:00PM. The examiner can also be reached on alternate Fridays during the same hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Ayaz Sheikh*, can be reached on (703) 305-9648 or via e-mail addressed to [ayza.sheikh@uspto.gov]. The fax number for this Group is (703) 305-3718.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [raymond.phan@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

*RR*  
*Raymond Phan*  
*Apr 6, 1999*

*Ayaz Sheikh*  
AYAZ R. SHEIKH  
SUPERVISORY PATENT EXAMINER  
GROUP 2700